REMARKS

Claims 12 and 13 are pending. Claims 1 and 7 are cancelled without any prejudice to, or disclaimer of, the subject matter they contain. Applicant retains the right to file continuing applications. Claim 12 is amended to encompass infringing subject matter. No new matter is added.

REJECTIONS UNDER 35 U.S.C. § 102

The Office Action rejects claims 1, 7, 12 and 13 under 35 U.S.C. §102(b) as allegedly being anticipated by Dow et al. and Yang (U.S. Patent No. 4,446,153). Applicant respectfully traverses these rejections for at least the following reasons.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention. *The Kegel Co. v. AMF Bowling,* 127 F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); *Gechter v. Davidson,* 116 F.3d 1454, 43 USPQ2d 1030 (Fed. Cir. 1997). In rejecting a claim under 35 U.S.C. § 102, the Patent Office is required to identify where a particular reference identically discloses each feature required by the rejected claim. *In re Rijckaert,* 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). There are significant differences between the claimed invention and each of Dow et al. and Yang.

Contrary to the Advisory Action's assertion, the claimed invention is not an intended use of a known composition. Rather, the claimed invention stems, in part, from the discovery that benzyl alcohol can be selected for its superior toxic effects against termites. (See at least Example 1 and the last paragraph on page 8 continuing on to page 9 of the specification). In particular, the claimed invention is directed to compositions and methods using the compositions for killing termites in which benzyl alcohol (the active ingredient) is ***selected on a basis of killing termites***.

Dow et al. merely discloses chlorohydrin as a carrier for benzyl alcohol in a spray formulation for direct application to plants against insects destructive to fruit trees, flowering plants and shrubs, such as aphis and other similar sucking insects, and the red spider. Dow et al. nowhere teaches or suggests that the disclosed benzyl alcohol-containing spray formulation is

toxic to termites, let alone that benzyl alcohol may be selected a basis of killing termites. At best, Dow et al. teach that chlorohydrin may be selected for use as a carrier for benzyl alcohol on a basis of its solvency.

Likewise, Yang merely discloses a teat and udder sanitizing solution effective for selectively reducing and inhibiting growth of gram positive and gram negative bacteria microorganisms as a preventative means against intra-mammary infection. In Example 10, Yang teaches that the disclosed teat dip will achieve a reduction in the geometric mean of the recoverable bacteria population found on teats and udders. Yang, however, does not teach that the disclosed compounds in Examples 9 and 10, e.g., benzyl alcohol, are toxic against termites, let alone that benzyl alcohol may be selected on a basis of its toxicity against termites, or that benzyl alcohol is present in the disclosed teat dip and udder sanitizing solutions in pesticidally-effective amounts to kill termites.

Applicant respectfully submits that in view of the deficiencies noted above, Dow et al. and Yang, alone or improperly combined, do not disclose or suggest each and every feature of the claimed invention. Moreover, neither Dow et al. nor Yang discloses or suggests Applicant's solution to the underlying technical problem of making available a product whose active ingredient is selected for its toxicity against termites, as required by the claimed invention. Dow et al. and Yang are conspicuously mute as to this fundamental concept. This fundamental difference alone between the claimed invention and each of Dow et al and Yang is sufficient to undermine the factual determination of lack of novelty under 35 U.S.C. § 102. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

As such, reconsideration and withdrawal of the rejection over Dow et al. and Yang are respectfully requested.

DOUBLE PATENTING

Claim 12 remains provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of copending Application No. 09/505,680 (45112-0058). In response, Applicant respectfully acknowledges the need to cancel or amend claims if ultimately allowed claims in the above-captioned patent

application improperly conflict with, or are coextensive in scope. Applicant respectfully requests that this rejection be held in abeyance until allowable subject matter is indicated.

CONCLUSION

Early consideration and prompt allowance of the pending claims are respectfully requested. If anything could be done to place this application in condition for allowance, (**e.g., an Examiner's Amendment**) Applicant respectfully requests that the Examiner contact the undersigned representative at the telephone number listed below.

Please grant any extension of time necessary for entry of this communication. Please charge any deficient fees, or credit any overpayment of fees, to Deposit Account No. 50-0417. A duplicate copy of this communication is attached.

Respectfully submitted,

Date: May 23, 2003

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 872-9307 on the date indicated below, with a coversheet addressed to Assistant Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C., 20231.

Date: May 23, 2003

By: Kelli N Watson
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